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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,594	11/16/2001	Leland R. Nevill	500060.02	6204

7590

07/28/2003

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EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,594

Applicant(s)

NEVILL, LELAND R.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. Receipt is acknowledged of the applicant response filed 5/16/03.

Reissue oath or declaration

2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

3. Claims 1-34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

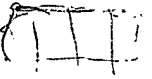
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beffa, US patent No. 5,927,512, in view of Markman, US Patent No. 5,962,834.

Beffa discloses a method for sorting integrated circuit devices comprising: fabricating IC's on wafers from a wafer lot 74, the IC's fabricated on the wafers are then programmed in a program with a fuse identification (ID) unique to each IC, the fuse ID may identify a wafer lot ID, the week the IC's were fabricated, a wafer ID, a die location on the wafer, and a fabrication facility ID. It will be understood, of course; conducting a test where the fuse ID's are

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automatically read and stored in association with test data 82 generated in the test, the fuse ID's are read electronically, but they may also be read optically; reading the fuse ID of each IC; accessing the test data 82 to compare the read data (see figure 8 and col. 7, line 8+).



Beffa teaches that the code could be read optically, but fails to disclose or fairly suggest making each integrated circuit with respective optical identification code corresponding electronic identification information.

Markman discloses an inventory tracking and management apparatus with multi-function encoding unit comprising: an optical indicia 18; an RF code 12 for tracking items, the optical code can be attached or printed to the items. These codes are cross-reference with each other. (see col. 7, lines 10-51; col. 8, lines 8-22; and figures 2, 5).

In view of Markman's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Beffa to include both the electronic identification and optical identification (i.e. optical marking) for identifying the integrated circuits. Such modification would provide an alternating means for identifying the integrated circuits if one of the ID codes is damage or malfunction. Further, having both identification codes, the system could authenticate the integrated circuits without accessing the look up table by cross-referencing the optical code and the electronic code, which would expedite the verification process and would make the system more effective. Therefore, it would have been obvious an extension as taught by Beffa.

Response to Arguments

6. Applicant's arguments filed 5/16/03 have been fully considered but they are not persuasive. (see examiner remarks).

REMARKS:

In response to applicant's first argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining the references would provide an alternating means for identifying the integrated circuit devices in case one of the IDs is damaged. (see Beffa col. 5, lines 20-23 and col. 6, lines 48-51).

In response to the applicant's second argument that electronic ID and the optical ID are not correlated, the examiner respectfully disagrees. Both IDs are used to identify the integrated circuits wherein they could be used alternately if one is damaged, they are correlated (see Beffa col. 5, lines 20-23 and col. 6, lines 48-51).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicant arguments regarding the independent claims 1, 6, 10, 19, 23, 28, and 32 that the concept of reading the electronic ID and a look up table is access to associate the optical ID is not disclosed, the examiner respectfully disagrees. The look up table (i.e. test data 24) correspond to both electronic ID and the optical ID, when the electronic ID is read, the

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test data is accessed to associate (verify) the ID code (i.e. electronic ID and/or optical ID). The applicant's arguments are not persuasive. Refer to the rejection above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

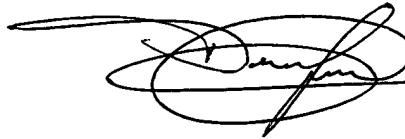
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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Daniel St.Cyr
Primary Examiner
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DS
July 25, 2003

A handwritten signature in dark ink, appearing to read 'Daniel St. Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.